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Paper No. 8

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DEC 26 2001

OFFICE OF PETITIONS

In re Application of
Seo, et al.
Application No. 09/816,599
Filed: March 23, 2001
Attorney Docket No. AB-1111 US
Title: SEMICONDUCTOR PACKAGE INCLUDING:
STACKED CHIPS

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition, filed August 29, 2001, under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 petitioner is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on March 23, 2001. On June 19, 2001, petitioner was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, petitioner filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a one month extension of time. Accompanying the petition were: (1) a declaration of facts by Attorney James E. Parsons, describing the efforts to obtain signatures from inventors Jae Hun Ku and Jae Hak Yee; and (2) copies of cover letters, signed by Attorney Axel Chan, dated April 16, 2001 and May 18, 2001.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the **application papers (specification, claims and drawings)**; (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor(s). The instant petition does not satisfy requirement (1).

As to item (1), the petition and accompanying evidence have been carefully considered. However, it has not been demonstrated that a copy of the application papers (comprising the specification, claims, and drawings) was sent to the non-signing inventors.

Regarding an inventor's refusal to join in the application, the Manual of Patent Examining Procedure states:

It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 U.S.P.Q. 80 (Comm'r Pat. 1956).

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

MPEP 409.03(d).

Here, petitioner has only demonstrated that an attempt was made to contact the non-signing inventors (through counsel) to determine whether they were "willing to review the applications and sign the respective Declarations for Patent Application and Power of Attorney, and Assignments." Letter of April 16, 2001 (emphasis added). The letter does not indicate that any of the application papers were in fact enclosed. Furthermore, the Declaration of James E. Parsons also does not state that the application papers were sent to the nonsigning inventors. On request for reconsideration, such statement must come from the person having firsthand knowledge that the application papers were sent.¹

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Cliff Congo at (703) 305-0272.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ "The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted." MPEP 409.03(d).